

## **REMARKS**

The present application includes pending claims 1-48, all of which have been rejected. No claims are amended by this response. Claims 1, 15, 25, 30, and 35 are independent claims, from which claims 2-14, 16-24, 26-29, 21-34, and 36-48 depend, respectively. Applicants respectfully request reconsideration of the pending claims, in light of the remarks set forth below.

The Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, **each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application**, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, **USPTO personnel should state all reasons and bases for rejecting claims in the first Office action**. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

## Rejections of Claims

Claim 1-48 were rejected on grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,483,985, claims 131 of U.S. Patent No. 7,424,534, and claims 1-33 of U.S. Patent Application No. 10/675,410. Claims 1-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 7,065,778 ("Lu") in view of U.S. 20020154892 ("Hoshen"), in further view of U.S. 20040125789 ("Parker"). Applicants respectfully traverse the rejections for the reasons set forth during prosecution, and those presented below.

### I. Non-Statutory Obviousness Type Double Patenting

Claims 1-48 were rejected on grounds of non-statutory obviousness type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7,483,985, claims 1-31 of U.S. Patent No. 7,424,534, and claims 1-33 of U.S. Patent Application No. 10/675,410. Applicants respectfully traverse the rejection for at least the following reasons.

According to M.P.E.P. §804(II)(B)(1), "...the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re* Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re* Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985)." The M.P.E.P. goes on to state:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

(emphasis added)

In addition, M.P.E.P. §804(II)(B)(1)(a) states, in part, "...[u]nless a claimed invention in the application would have been anticipated by, or obvious over a claimed invention in the patent, no double patenting rejection of the obvious-type should be made...."

Applicants respectfully submit that the Office has not established a *prima facie* case of either anticipation or obviousness with respect to claims 1-48 over the cited claims of any of U.S. Patent No. 7,424,534, U.S. Patent No. 7,483,985, or Application Serial No. 10/675,410. Initially, the support provided by the Office for this rejection is simply a two-column listing of the language of only claims 1-5 of the Application, aligned with claim 1 of Application Serial No. 10/675,410 and claims 1-5 of U.S. Patent No. 7,424,534. **The Office fails to even address rejected claims 6-48 of the Application, and fails to address any of the claims of U.S. Patent No. 7,483,985.**

Further, although the Office has arranged selected claims in a side-by-side format, the Office fails to provide the required "...reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention...." Applicants respectfully submit that the Office does not provide any explanation of why the elements of Applicants' claims are either anticipated or obvious in view of the cited claims of U.S. Patent No. 7,424,534, U.S. Patent No. 7,483,985, or Application Serial No. 10/675,410. Instead, the Office offers only the conclusory statement:

Although the conflicting claims are not identical, they are not patentably distinct from each other because the content of these claims is not exactly the same. All of these applications claims a system supporting concurrent consumption of media from multiple sources; a first and second television with storage for storing and distributing multimedia; software that maintain a user defined of the first and second network protocol addresses etc.. The limited differences includes supporting the exchange of media, providing search functionalities to support the exchange, and 3rd party media, are obvious variations that would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the known technique of the Patents and copending application to the system.

Further, Applicants respectfully submit that the cited claims of the Application and the cited claims of U.S. Patent No. 7,424,534, U.S. Patent No. 7,483,985, and Application Serial No. 10/675,410 recite different features and patentably distinct subject matter, and that the Office has not shown that a non-statutory obviousness-type double patenting rejection is appropriate in that it has not shown where "...at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s)." Applicants respectfully submit that the Office action merely offers the following conclusory statement, at page 4:

The limited differences includes supporting the exchange of media, providing search functionalities to support the exchange, and 3rd party media, are obvious variations that would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the known technique of the Patents and copending application to the system.

Applicants respectfully submit that M.P.E.P. §2142 recognizes that "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness," and that "**rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" (emphasis added) Further, M.P.E.P. §2143.03 clearly recognizes that "[t]o establish *prima facie* obviousness of a claimed invention, all **the claim limitations** must be taught or suggested by the prior art." (emphasis added).

For example, Applicants respectfully submit that the Office action fails to even show every feature of claim 1 of U.S. Patent Application No. 10/675,410, which recites the following feature not addressed in the Office action:

first software that maintains a user defined group of users comprising the first and second users, wherein the user defined group of users is closed and secure with

respect to others that are not members of the user defined group of users, wherein a member within the user defined group of users can privately share media content comprising audio and/or video with one or more other members within the user defined group of users, wherein the first software receives a request identifying one of the associated first and second network addresses, and responds by identifying the other of the associated first and second network addresses to support transmission of the media content comprising audio and/or video from the at least one first media peripheral to the second television display for consumption in a real time manner;

Applicants also respectfully submit that claim 1 of the Application recites features not recited by cited claim 1 of U.S. Patent Application No. 10/675,410, which recites, *inter alia*:

first software that maintains a user defined association of the first and second network protocol addresses, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses to support delivery via the communication network of the 3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the 3<sup>rd</sup> party media by the first television, and the 3<sup>rd</sup> party media and the first media by the second television;

Further, the Office has not even addressed the alleged obviousness of the claims of the Application and any claims of U.S. Patent No. 7,483,985.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of either anticipation or obviousness, as required by M.P.E.P. §804(II)(B)(1), that a non-statutory obviousness-type double patenting rejection is inappropriate, and respectfully request that the non-statutory obviousness-type double patenting rejection of claims 1-48 be withdrawn.

## II. The Proposed Combination Of Lu, Hoshen, And Parker Does Not Render Claims 1-48 Unpatentable

Claims 1-48 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 7,065,778 ("Lu") in view of U.S. 20020154892 ("Hoshen"), in further view of U.S. 20040125789 ("Parker"). Applicants respectfully traverse the rejections.

Applicants respectfully note that all pending claims are rejected for alleged reasons of obviousness. Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142.

Applicants first review requirements for a rejection based on obviousness. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

In addition, as noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03. Further, "**[a]ll words in a claim** must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination in an effort to assert a quick and easy rejection. Instead, all the words in a claim must be considered during the examination process.

**With regard to independent claim 1**, Applicants respectfully submit that claim 1 recites, *inter alia*, "second software configured to enable a user at the first home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." Independent claims 15, 25, 30, and 35 recite similar language. The Applicants respectfully submit that the proposed combination of Lu, Hoshen, and Parker does not describe, teach, or suggest all aspects of Applicants' claims 1, 15, 25, 30, and 35.

Initially, Applicants respectfully submit that the rejection of claim 1 in the instant Office action is identical to the rejection of claim 1 set forth in the previous Office action. Compare February 2, 2010 Office action at pages 3-6 to August 31, 2010 Office action at pages 7-10. Applicants addressed the alleged teachings of the cited art in detail at pages 16-28 of the response filed June 2, 2010. Applicants will not repeat all of the arguments of June 2, 2010 again here, but hereby incorporate them herein as though set forth in full.

Applicants respectfully note that M.P.E.P. §707.07(f) states, in part:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, **an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.**

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

**Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.**

Thus, the Examiner has an **obligation** to not only respond to the arguments presented by the Applicants, but to address the substance of those arguments.

Applicants respectfully submit that the Office purportedly responds to Applicants' arguments of June 2, 2010 in the "Response to Arguments" at pages 2-3 of the August 31, 2010 Office action, which is reproduced below:

### **Response to Arguments**

2. Applicant's arguments with respect to claims 1-48 have been considered but applicant's arguments are not persuasive. Applicant argues that non of the cited references alone or in combination teach or suggest, "second software configured to enable a user at the first home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." Examiner has fully considered applicant's argument, however, does not agree with applicant's argument for at least reason below.

3. In response to applicant's argument, examiner would like to clarify that Parker teaches wherein second software configured to enable a user at the first home to construct (a network-enabled personal computer workstation 14; Fig. 1), at the first home, at least one user defined media channel (see VT and Record Database Server 35; Fig. 1), the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home (see fig. 1 and details wherein a data network interconnects the service provider workstation and the requester communication device, and the service provider workstation and the requester communication device have respective network addresses. A requester information database stores a data record corresponding to the requester. The requester communication device includes a signaling device for generating a request signal and a controller responsive to the request signal for initiating a video communication link between the requester communication device and the service provider workstation using the respective network



addresses and for initiating display of the data record at the service provider workstation). Thus for at least given reason of Parker's teaching, it is examiner's position that cited references teach each and every limitations of applicant's claimed invention.

Applicants respectfully submit that the response of the Office to the substance of more than 12 pages of Applicants' response of June 2, 2010 is located in just the second paragraph above. As can be seen above, the Office states that "[i]n response to applicant's argument, **examiner would like to clarify....**" (emphasis added) Applicants respectfully submit, however, that the second paragraph shown above fails to clarify anything, in that the text shown above **is nothing more than a verbatim copy of text taken from the rejection of claim 1 as set forth in the previous Office action.** Compare item 10 of the February 2, 2010 Office action at pages 5-6 to item 3 of the August 31, 2010 Office action at pages 2-3. Applicants respectfully submit that no "clarification" has occurred. Further, as noted above, the present rejection of claim 1 is identical to and is therefore merely a repeat of the rejection set forth in the February 2, 2010 Office action. However, the Office has not addressed the substance of Applicants' arguments to this repeated rejection, as required by M.P.E.P. §707.07(f), but instead simply repeats a part of the rejection to which Applicants' response was directed.

Applicants respectfully submit that the Office again admits that Lu and Hoshen in combination do not disclose at least the above aspect of Applicants' claim 1. See August 31, 2010 Office action at pages 9-10. The Office, however, then turns to Parker, and states the following:

10. In analogous teaching, Parker exemplifies this where Parker teaches wherein second software configured to enable a user at the first home to construct (a network-enabled personal computer workstation 14; Fig. 1), at the first home, at least one user defined media channel (see VT and Record Database Server 35; Fig. 1), the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home (see fig. 1 and details

wherein a data network interconnects the service provider workstation and the requester communication device, and the service provider workstation and the requester communication device have respective network addresses. A requester information database stores a data record corresponding to the requester. The requester communication device includes a signaling device for generating a request signal and a controller responsive to the request signal for initiating a video communication link between the requester communication device and the service provider workstation using the respective network addresses and for initiating display of the data record at the service provider workstation).

(emphasis added)(See Office action at page 10.)

As an initial point, Applicants respectfully submit that the Office fails to specifically cite any text from Parker to shed light on why the Office selected the elements of Parker identified above, and merely copies the underlined portion of text that appears at the Abstract and paragraph [0009]. The Office fails to explain how this portion of Parker supports the rejection by teaching Applicants' claimed subject matter, as required by M.P.E.P. §2142. In particular, the Office does not explain specifically how and why the identified elements and the underlined text from Parker teach all of the features of Applicants' claim 1 admittedly missing from the proposed combination of Lu and Hoshen. This defect of the instant Office action is common to the arguments presented over the features of at least claims 1, 15, 25, 30, and 35. Thus, Applicants respectfully maintain that the Office has not established a *prima facie* case of obviousness at least because the Office does not explicitly demonstrate how all aspects of Applicants' claim 1 are taught by the cited art.

Applicants respectfully maintain that the invention of Parker relates to "a video telephony system for conducting communications supplemented by presenting digital data records to a service provider automatically in response to a video telephony call." *Id.* at para. [0003].

Applicants respectfully maintain that Parker teaches a "computer workstation 14" is used by a "service provider," described by Parker as a "medical caregiver." *Id.* at Abstract. The "medical caregiver" receives video telephony calls initiated by a "service

requester" (a "medical patient") from the location of a "requester communication device." *Id.* at Abstract and ¶[0019]. Video calls to the "medical caregiver" are initiated from the "requester communication device" manually (e.g. by push button) or automatically (e.g., caused by telephone call to particular number or by "patient monitor 33"). *Id.* at paras. [0020], [0023], [0024]. A "data record" stored in a "requester information database 35" or provided by the "requester communication device" is made available to the "medical caregiver" at "computer workstation 14." *Id.* at Abstract, paras. [0018], [0022], [0024].

The Office seems to assert that the "network enabled personal computer workstation 14" of FIG. 1 of Parker teaches Applicants' "second software configured to enable a user at the first home to construct, [at the first home, at least one user defined media channel]." *See* August 31, 2010 Office action at page 10. The Office also seems to assert that the "VT and Record Database Server 35" somehow teaches Applicants' "at least one user defined media channel." *Id.* In addition, the Office seemingly asserts that the "data network" of Parker teaches Applicants' claimed "second software" that enables "enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." *Id.* Applicants again respectfully disagree that Parker teaches what is asserted, and disagree that Parker remedies the admitted failings of Lu and Hoshen. Applicants respectfully submit that Parker is deficient for a number of reasons.

Applicants respectfully submit that the Office has not shown where and how Parker teaches, suggests, or discloses "closed and secure communication of the at least one user defined media channel **to others** (plural) **within a user defined group** that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." As noted above, the Office seems to assert that the "network enabled personal computer workstation 14" of FIG. 1 of Parker teaches Applicants' "second software configured to enable a user at the first home to construct, [at the first home, at least one user defined media channel]." Also as noted above, the Office seems to assert that the "VT and Record Database Server 35" somehow teaches Applicants' "at least one user defined media channel." Applicants respectfully submit,

however, that Office has failed to demonstrate that Parker teaches communication of any piece of information from the “VT and Record Data Server 35” to a plurality of recipients from the location of the “service provider/medical caregiver,” in accordance with claim 1. Instead, Parker merely teaches that the “data record” corresponding to a “requester” is displayed at the “service provider workstation.” See *id.* at Abstract; Ref. 67 of FIG. 5; paras. [0003], [0008], [0009], [0020], [0025], [0033]. Thus, for at least these reasons, Applicants respectfully submit that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from the proposed combination of Lu and Hoshen.

In addition, Applicants respectfully maintain that Applicants’ “at least one user defined media channel” is quite different from the “VT and Data Record Server 35,” which the Office asserted teaches this aspect of claim 1. Applicants’ disclosure teaches, *inter alia*, that a “media channel” comprises “personal digital media (e.g., captured digital pictures, digital video, digital audio, etc.).” Application at para. [0062]. Applicants respectfully submit that while limitations from the Specification are not to be read into the claims, the claims are to be given their broadest reasonable interpretation, **consistent with the Specification**. See M.P.E.P. §904.01 and §2145(VI). Applicants respectfully submit that interpretation of Applicants’ “at least one user defined media channel” as a “server” is not consistent with the teachings of Applicants’ Specification. The Office has not explicitly demonstrated that Parker teaches, suggests, or discloses that the “server 35” comprises “digital media” of the types described by Applicants’ Specification. Thus, for at least these reasons, Applicants respectfully maintain that Parker fails to teach, suggest, or disclose at least this aspect of Applicants’ claim 1 admittedly missing from the proposed combination of Lu and Hoshen.

If the Office meant to assert that a requester “data record” stored on the “VT and Data Record Server 35” teaches Applicants’ “at least one user-defined media channel,” Applicants respectfully maintain that the Office has not explicitly demonstrated that Parker teaches, suggests, or discloses that the requester “data record” of Parker is “constructed” by the “service provider/medical caregiver.” Parker teaches that the “data record” corresponding to a “request” is sent from the “requester communication device”

or another location, and that the "service provider" may "update" a "data record" of a "requester." *See, e.g., id.* at Refs. 63 and 68 of FIG. 5; Ref. 86 of FIG. 6; paras. [0006], [0008], [0009], [0018], [0025], [0026]; [0027], [0030], [0034], and [0036]. Therefore, Applicants respectfully submit that Parker teaches, at most, that the "service provider/medical caregiver" may modify a "data record," but the Office does not show where Parker teaches "construction." In addition, as noted above, the Office fails to explicitly demonstrate that Parker teaches, suggests, or discloses that any "data record" is communicated to "others" (plural) of a "closed and secure group of users," as required by Applicants' claim 1. Instead, Parker simply teaches that the "data record" corresponding to a "requester" is, for example, "one or more computer files" pertaining to the "requester." *See* paras. [0008], [0018], [0027]. Further, Parker teaches that the "data record" corresponding to a "requester" is merely displayed at the service provider workstation. *See id.* at Abstract; Ref. 67 of FIG. 5; paras. [0003], [0008], [0009], [0020], [0025], [0033]. Thus, for at least these reasons, Applicants respectfully maintain that Parker fails to teach, suggest, or disclose at least this aspect of Applicants' claim 1 admittedly missing from the proposed combination of Lu and Hoshen.

Therefore, for at least the reasons set forth above, Applicants respectfully maintain that, contrary to the repeated assertions of the Office, Parker does not remedy the admitted deficiencies of Lu and Hoshen. The Office again admits that Lu and Hoshen do not teach, suggest, or disclose, at least, "second software configured to enable a user at the first home to construct, at the first home, at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to others within a user defined group that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home." *See* August 31, 2010 Office action at page 9. Applicants have again demonstrated that Parker also does not teach, suggest, or disclose these features of Applicants' claim 1. Because the Office admits that Lu and Hoshen do not teach, suggest, or disclose at least these aspects of claim 1, and Applicants have demonstrated that Parker also does not teach, suggest, or disclose at

least these aspects of claim 1, it necessarily follows that the proposed combination of Lu, Hoshen and Parker cannot teach, suggest, or disclose at least these aspects of claim 1. Applicants respectfully submit that the Office therefore has not established a *prima facie* case of obviousness, as required by M.P.E.P. §2142 for at least the reasons set forth above. Applicants respectfully submit that the Office has not met the burden of establishing a *prima facie* case of obviousness for at least an additional reason.

Applicants respectfully submit that claim 1 also recites, in part, “software that maintains a user defined association of the first and second network protocol addresses, that receives a request that identifies one of the associated first and second network protocol addresses and responds by identifying the other of the associated first and second network protocol addresses to support delivery via the communication network of the 3<sup>rd</sup> party media from the at least one server, and the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the 3<sup>rd</sup> party media by the first television, and the 3<sup>rd</sup> party media and the first media by the second television.”

In the instant rejection, the Office again relies only upon Lu and only at col. 6, lines 21-28 and “display 212” of “PVR 200,” asserting that these cited portions of Lu alone teach, at least, “the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the 3<sup>rd</sup> party media by the first television, and the 3<sup>rd</sup> party media and the first media by the second television.” The Office does not assert that Hoshen and/or Parker provide any support in regard to rejection of these aspects of claim 1. Applicants respectfully disagree with what Lu is asserted to teach.

A review of Lu shows that “display device 212” appears in FIG. 2, FIG. 3, and FIG. 4, but none of those illustrations of the system of Lu teaches, suggests, or discloses, at least, “the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the 3<sup>rd</sup> party media by the first television, and the 3<sup>rd</sup> party media and the first media by the second television,” contrary to the conclusory statement by the Office. That is, there is nothing in FIGs. 2, 3, or 4 that teaches anything about

consumption of "3<sup>rd</sup> party media" from a "server" by a television at a "first home," **concurrent** with consumption, by a second television at a "second home," of the "3<sup>rd</sup> party media" **and** "media from a storage at the first home." **It is simply not there.** Further, the Office fails to provide the "explicit analysis" required by M.P.E.P §2142 to explain how Lu is interpreted to teach what is asserted. Applicants now turn to Lu at cited col. 6, lines 21-29, which is shown below"

... information and instructions. An optional display device 212 is coupled to bus 210 of personalized video recorder 200 for displaying video and/or graphics. It should be appreciated that optional display device 212 may be a cathode ray tube (CRT), flat panel liquid crystal display (LCD), field emission display (FED), or any other display device suitable for displaying video and/or graphic images and alphanumeric characters recognizable to a user.

Applicants respectfully maintain that the portion of Lu shown above fails to make any mention of concurrent consumption of media at first and second homes, let alone that a television at the "first home" consumes media from a "3<sup>rd</sup> party," while a second television at the second home consumes the media from the "3<sup>rd</sup> party" **and** media from a storage at the "first home." Instead, the cited portion of Lu, specifically selected by the Office, simply explains that "display device 212" may be "cathode ray tube (CRT), flat panel liquid crystal display (LCD), field emission display (FED), or any other display device suitable for displaying video and/or graphic images and alphanumeric characters recognizable to a user." Thus, the Office has not demonstrated that Lu teaches, suggests, or discloses "the first media from the first storage, to the second home, and the 3<sup>rd</sup> party media from the at least one server, to the first home, for concurrent consumption of the 3<sup>rd</sup> party media by the first television, and the 3<sup>rd</sup> party media and the first media by the second television." Because Lu does not teach, suggest, or disclose at least this aspect of Applicants' claim 1, and the Office has not even asserted that either Hoshen or Parker teach anything in this regard, Applicants respectfully submit that it necessarily follows that the Office has not shown that the proposed combination of Lu, Hoshen, and Parker teaches, suggests, or discloses at least this aspect of Applicants' claim 1. Applicants respectfully maintain that claim 1 is therefore

not rendered unpatentable by the cited art, and is allowable over the cited art for at least these additional reasons set forth above. Applicants respectfully submit that claim 1 is allowable for at least an additional reason.

Applicants respectfully submit that the rejection of claim 1 again consists simply of the text of Applicants' claim 1, interspersed with citations to portions of Lu, Hoshen, and Parker. For example with respect to the rejection of admitted deficiencies in Lu and Hoshen, the Office simply reproduces Applicants' claim text, inserts vague references to two elements of FIG. 1 of Parker, adds, verbatim, text that appears in both the Abstract and paragraph [0009] of Parker (without identifying its source), and then concludes with the conclusory statement:

Thus, given the teaching of Parker, it would have been obvious to one of the ordinary skill persons in the art of networking to modify the teaching of Lu-Hoshen into Parker for a software configured user enabled media communication channel within peer network for motivation of efficient deployment of media caregiver or other service provider resources while increasing the quality and information content of communication (see Parker par. 0008).

Applicants respectfully maintain that the Office fails to provide the "explicit analysis" and "articulated reasoning," required by M.P.E.P. §2142, to explain how and why Parker teaches what is alleged. Applicants respectfully submit that, without explanation by the Office of specifically what in Parker teaches each element of Applicants' claim 1, the assertion by the Office is nothing more than a conclusory statement that "Parker teaches," and Applicants' efforts to reply to the arguments of the Office are made unnecessarily difficult.

Applicants respectfully maintain that the M.P.E.P. §2142 is clear that conclusory statements are not sufficient to support a rejection under 35 U.S.C. §103, that the Office **must** provide an "explicit analysis" of why the claimed invention is obvious in view of the cited art. See M.P.E.P. §2142. Applicants respectfully submit that claim 1 is allowable for at least the reason that the Office has not met the requirements of M.P.E.P. §2142 in this regard.



**Therefore, should the Office choose to maintain the rejection, Applicants once again respectfully request that the Office specifically identify the relevant portions of the cited art, down to paragraph/column and line(s) and elements of figures that allegedly teach each and every element of Applicants' claims.**

For example, with regard to the aspects of claim 1 admittedly missing from Lu and Hoshen, Applicants respectfully request that the Office explain which of the specific teachings of Parker allegedly correspond to Applicants' claimed "user at the first home" and "at least one user defined media channel" and why? What from Parker teaches Applicants' "construct[ion], at the first home" of the "at least one user defined media channel," and why? What from Parker teaches the "others" to whom communication of the "at least one user defined media channel" is made, and why? What in Parker teaches Applicants' "user defined group," and why? What from Parker teaches the communication of the "at least one user define media channel" to the "others" of a "user defined group," and why? Applicants respectfully maintain that the instant Office action, which merely repeats the rejections of the February 2, 2010 Office action, does not answer those questions and merely repeats a portion of the rejection of claim 1 taken from the February 2, 2010 Office action. Therefore, Applicants respectfully submit that the Office has not provided the "explicit analysis" and "articulated reasoning" required by M.P.E.P. §2142, and that claim 1 is allowable for at least this reason.

**With regard to independent claims 15, 25, 30, and 35,** Applicants respectfully submit that claims 15, 25, 30, and 35 recite many of the same features and were rejected over the same art for the same reasons set forth in the rejection of claim 1, and that claims 15, 25, 30, and 35 are allowable over the cited art for at least some of the reasons set forth above with respect to the rejection of claim 1.

Therefore, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to any of independent claims 1, 15, 25, 30, and 35, as required by M.P.E.P. §2142, that claims 1, 15, 25, 30, and 35 are not rendered unpatentable by the cited art, and that claims 1, 15, 25, 30, and 35, and any claims that depend therefrom are allowable over the proposed combination of Lu, Hoshen, and Parker. Accordingly, Applicants respectfully request that the rejection of

claims 1-48 under 35 U.S.C. 103(a) be reconsidered and withdrawn.

### III. Obviousness Guidelines

Additionally, referring to the PTO's published guidelines of October 10, 2007, with regard to the procedure to be followed by Examiners when making an obviousness rejection, the guidelines recite seven rationales supporting an obviousness rejection and give specific findings that must be made by an Examiner in order for the Examiner to use the rationale to support a finding of obviousness. These findings are not optional and must be articulated by the Examiner for the rationale to apply. The seven rationales are shown below.

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

If the present rejections is maintained, or any new rejection based on obviousness is asserted, however, the Applicants respectfully request that any

subsequent action: 1) **identify the specific Rationale** (i.e., by explicitly indentifying one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejection so that the Applicants may more clearly address the Examiner's concerns, and 2) **state on the record the required** factual findings to support the Rationale that the Examiner has chosen.

As indicated recently, "[i]t is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in *KSR* and discussed in the *2007 KSR Guidelines*, they are to adhere to the instructions provided in the MPEP regarding the **necessary factual findings**." See September 1, 2010 Examination Guidelines Update, 75 Fed. Reg. 169.

Indeed, "if a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel **must** either withdraw the rejection, or repeat the rejection **including all the required factual findings**." See *id.*

Further, "[s]imply stating the principle ... without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness." See *id.*

"[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

Thus, as indicated above, the Applicants respectfully request that any subsequent Office Action that asserts an obviousness rejection **specifically identify** which rationale it is using, and then provide **the required factual findings** with respect to the rationale.

## Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a future claim rejection).

The Applicants respectfully submit that the Office Action has not established a *prima facie* case of anticipation or obviousness with respect to any of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney for Applicants.

The Commissioner is authorized to charge any fees required by this submission, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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